



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/809,533 | 03/25/2004 | Vincent Kubert | 29744-CON | 6153 |

7590 05/26/2005

RICHARD K. WARTHER
Allen, Dyer, Doppelt, Milbrath & Gilchrist, P.A.
P.O. Box 3791
Orlando, FL 32802-3791

| |
|----------|
| EXAMINER |
|----------|

YAN, REN LUO

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2854

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

A

E

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/809,533 | KUBERT ET AL. | |
| | Examiner | Art Unit | |
| | Ren L. Yan | 2854 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 16 March 2005.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 49-80 is/are pending in the application.

4a) Of the above claim(s) 69-80 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 49-68 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/25/04, 6/4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

U.S. Patent and Trademark Office
PTOL-326 (Rev. 1-04)

Office Action Summary

Part of Paper No./Mail Date 20050523

DETAILED ACTION

Applicant's election of Group I, claims 49-68 in the reply filed on 3-16-2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 49-68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,729,656. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-22 in the patent teach all that is claimed by the method claims 49-68 of the present application and the mere difference between claims 49-68 of the present application and claims 1-22 of the patent is that claims 49-68 of the present application are broader in scope.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49, 51, 52, 54-59, 61, 62 and 64-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scupham(WO 97/43126) in view of Deshiens et al(5,803,504).

Scupham teaches a card printing method as claimed including printing “secret” text(numbers or symbols that form a PIN) on a substantially rigid plastic card that is substantially rectangular and wallet sized, printing a release layer over the printed “secret” text, printing an ultraviolet curable opaque scratch-off coating over the release layer, and then UV curing the surface of the printed card. See the entire Scupham document for details.

However, Scupham does not teach to use a flexographic printing to carry out the printing operation. Deshiens et al teach a method for multicolor overprinting of scratch-off lottery tickets using a multi-station flexographic printing press to print indicia 41 representing game symbols and prize amounts, varnish layers 43 and 45 to protect the printed indicia 41, and a scratch-off layer 46 on top of the varnish layers. Deshiens et al also teach to further print a multicolor complex image over the scratch-off layer to form an overprint region 58. See Figs. 1-8 and column 5, lines 4-63 in Deshiens et al for example. It would have been obvious to one of ordinary skill in the art to provide the printing method of Scupham with the multicolor flexographic printing press as taught by Deshiens et al in order to enable various ink layers printed flexographically in order to achieve the desired visual effect of full color with virtually limitless tones and shades.

With respect to claims 54, 55, 64 and 65, as discussed above, Deshiens et al teach to further print a multicolor complex image over the scratch-off layer to form an overprint region. The multicolor complex image over the scratch-off layer would inherently be considered as a security indicia or the control code to the maker of the cards.

Claims 50 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scupham in view of Deshiens et al as applied to claims 49 and 59 above, and further in view of Person(5,989,639).

Scupham, as modified by Deshiens et al, teaches all that is claimed except for showing the detailed structural arrangement of the flexographic printing press. The patent to Person teaches the conventionality of using an anilox metering roller 58 to transfer closely controlled quantities of ink to a printing plate cylinder in a flexographic printing press. See

column 6, lines 9-22 in Person for example. It would have been obvious to one of ordinary skill in the art to provide the flexographic printing press of Scupham, as modified by Deshiens et al with the anilox metering roller for each of the flexographic printing stations as taught by Person in order to precisely control the amount of the ink being transferred to and printed by the flexographic printing cylinders.

Claim 53 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scupham in view of Deshiens et al as applied to claims 49 and 59 above, and further in view of Templeton(6,152,029).

Scupham, as modified by Deshiens et al, teaches all that is claimed except for the use of an inkjet printer. Templeton teaches printing on a card with a magnetically encoded stripe the conventional use of inkjet printheads 30 and 32 for applying variable text and bar code information such as PIN number or other security information onto the card. See column 3, lines 3-22 in Templeton for example. In view of the teaching of Templeton, it would have been obvious to provide the card printing method of Scupham, as modified by Deshiens et al, with the inkjet printheads appropriately disposed to facilitate printing variable text and bar code information on the card over the opaque scratch-off layer with precise digital control of the inkjet printing technology.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

Art Unit: 2854

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
May 23, 2005